

III. REMARKS

Claim 1 has been amended by this paper and claims 4-5 have been canceled. As a result, claims 1-3 and 9-15 remain pending in this application. These amendments are being made to facilitate early allowance of the presently claimed subject matter.

Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed.

Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

Initially, Applicant thanks the Examiner for the telephone interview of June 7, 2007 with their representative, Darrell Pogue, Reg. No. 57,878. During the interview, the independent claim was discussed with respect to its corresponding rejections. No exhibits were presented and no agreement was reached. The substance of the interview is incorporated in the following remarks.

In the Office Action, claims 1-5 and 9-15 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Claim 1 is rejected under 35 U.S.C. §101 as allegedly lacking patentable utility.

A. REJECTION OF CLAIMS 1-15 UNDER 35 U.S.C. §112, SECOND PARAGRAPH

The Office has asserted that claims 1-5 and 9-15 are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention. Specifically, the Office first asserts that a computer does not obtain this information. In response, Applicant has amended claim 1 to recite, *inter alia*, the limitation of “carrying out computerized evaluation of capital market financial assets, including[.]” Accordingly, Applicant submits that claim 1 clearly recites a computerized evaluation and respectfully request withdrawal of the rejection.

Second, the Office asserts that the term “market business information” is indefinite and vague. Office Action, p. 2. In response, Applicant points to p. 13, paragraph 2 of Applicant’s Specification. In particular, paragraph 2 recites, *inter alia*, that “in a first process phase, the financial market under evaluation is researched 10 in order to obtain all market business information 12 necessary for the following market evaluation phases. The next three phases, as marked by the dotted line, are all part of the central evaluation process.” Applicant submits that the Office is confusing claim breadth with claim definiteness. MPEP 2173.04 states that the breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. Applicant submits that “market business information” is definite and includes any information necessary for the each of the evaluation phases, as defined by Applicant’s Specification. Accordingly, Applicant respectfully requests withdrawal of the rejection.

In the Office Action, the Office asserts that the recited processing and subprocessing steps of claim 1 are vague. Office Action, pp. 2-3. In response, Applicant

has amended claim 1 to include the subject matter deemed allowable by the Office during the telephone interview as a further clarification of the processing and subprocessing steps. Accordingly, Applicant respectfully requests withdrawal of the rejection.

In the Office Action, the Office asserts that is not clear how the scoring relates to interlinked area. Office Action, p. 3. In response, Applicant has amended claim 1 to recite, *inter alia*, “wherein said four interlinked areas comprise twelve determinants, each determinant having an associated score[.]” Applicant submits that the results of the subscoreing process is used to provide a score corresponding to an assessment for an investment decision. This score is associated with each of the 12 determinants and their corresponding interlinked areas. Accordingly, Applicant submits that each of the claim elements are definite and respectfully request withdrawal of the rejection.

With respect to claims 14 and 15, Applicant herein incorporates the arguments presented above with respect to the independent claims from which the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

B. REJECTION OF CLAIM 1 UNDER 35 U.S.C. §101

The Office has rejected claim 1 for allegedly failing to satisfy the utility requirement. In response, Applicant has amended claim 1 to recite, *inter alia*, “wherein a recommendation for an investment decision is provided based on the associated score.” To this extent, Applicant submits that the claimed invention has a practical application within the technological arts, to wit, providing an investment recommendation. As such,

Applicant submits that the claimed invention is directed to statutory subject matter.

Accordingly, Applicant requests that the rejection be withdrawn.

C. CLAIM OBJECTIONS

In the Office Action, claim 1 is objected to because “obtained” and “gathered” is used interchangeably. In response, Applicant has amended claim 1 to provide consistent terminology. Accordingly, Applicant respectfully requests withdrawal of the rejection.

IV. CONCLUSION

In addition to the above arguments, Applicant submits that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicant does not acquiesce to the Office’s interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. These features have not been separately addressed herein for brevity. However, Applicant reserves the right to present such arguments in a later response should one be necessary.

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant’s undersigned representative at the number listed below.

Respectfully submitted,

Date: June 7, 2007

/Darrell L. Pogue/

Darrell L. Pogue

Reg. No.: 57,878

Hoffman, Warnick & D'Alessandro LLC
75 State Street, 14th Floor
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)